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| APPLICATION NO.                 | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------|----------------------|---------------------|------------------|
| 09/679,335                      | 10/04/2000  | Keith Henning        | COREMET-002         | 6561             |
| 34399                           | 7590        | 08/17/2004           | EXAMINER            |                  |
| GARLICK HARRISON & MARKISON LLP |             |                      | DURAN, ARTHUR D     |                  |
| P.O. BOX 160727                 |             |                      | ART UNIT            |                  |
| AUSTIN, TX 78716-0727           |             |                      | PAPER NUMBER        |                  |

3622

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/679,335

Applicant(s)

HENNING ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. Claims 1-20 have been examined.

#### *Response to Amendment*

2. The Amendment filed on 6/28/04 is sufficient to overcome the Gardenswartz reference.

#### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1-20 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 21-32 of copending Application No. 09/679,334. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are oriented to an invention with the same disclosed features.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1-3, 5-7, 12-15, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz (6,055,573) in view of Deaton (5,687,322).

Claim 1, 5: Gardenswartz discloses a method for accumulating consumer sales transaction data from a plurality of sales transaction sources for further use in targeted advertising, the method comprising the steps of:

standardizing the consumer sales transaction data such that the consumer sales transaction data conforms to a predetermined format (Fig. 2a; Fig. 2b);

storing the standardized consumer sales transaction data on a server comprising memory (Fig. 1; item 8);

accumulating the standardized consumer sales transaction data for each consumer such that a group of the consumer sales transaction data relating to a specific consumer is assigned to that consumer (Fig. 2a); and

segmenting the standardized consumer sales transaction data such that a group of consumers can be defined by the group's characteristics (Fig 4a; Fig. 9; Fig. 8; col 12, lines 37-48).

Gardenswartz further discloses online sales (col 1, lines 23-27) and tracking online sales data for consumer activity for targeted advertising purposes (col 2, lines 43-55).

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Gardenswartz further discloses targeted advertising to consumers utilizing known consumer information (col 2, lines 35-43).

Gardenswartz further discloses utilizing known consumer information such as consumer mailing address information to mail information to a consumer in an offline manner via regular mail (col 19, lines 17-14).

Gardenswartz further discloses providing coupons and rewards to a consumer in an offline manner such as regular mail, at a retail store, or at a checkout counter, (col 20, lines 10-25).

The online Merriam-Webster dictionary at [www.m-w.com](http://www.m-w.com) defines 'coupon' as:

“ ...

**2** : a form surrendered in order to obtain an article, service, or accommodation: as **a** : one of a series of attached tickets or certificates often to be detached and presented as needed **b** : a ticket or form authorizing purchases of rationed commodities **c** : a certificate or similar evidence of a purchase redeemable in premiums **d** : a part of a printed advertisement to be cut off to use as an order blank or inquiry form or to obtain a discount on merchandise”.

Definition 2d states how a coupon is related to an advertisement.

Additionally, Deaton further discloses utilizing consumer purchase history information to send targeted, offline or mailed advertisements or coupons to a consumer (col 7, lines 30-50; col 4, lines 3-10; col 61, lines 45-52; col 62, lines 53-56).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gardenswartz can utilize online consumer activity history in any of the manners disclosed for utilizing the offline activity history information. One would have been

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motivated to do this in order to form a more complete picture of user activity information for targeting purposes (col 2, lines 42-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gardenswartz's targeted offline coupon or rewards information delivered to a consumer based upon online sales information can be offline advertisements. One would have been motivated to do this in order to provide advertising in a form that is often utilized or accessed by consumers.

Claim 2: Gardenswartz and Deaton disclose the method of claim 1 and further discloses the step of cross referencing the standardized consumer sales transaction data with consumer sales transaction data accumulated from the plurality of sales transaction sources (col 5, line 65- col 6, line 15).

Claim 3: Gardenswartz and Deaton disclose the method of claim 1 wherein the step of standardizing includes grouping the consumer sales transaction data into a plurality of data fields that are separated by delimiters (Fig. 2a; Fig. 2b; col 8, lines 3-10).

Claim 6, 7: Gardenswartz and Deaton disclose a system for the accumulation and segmentation of consumer sales transaction data, the system comprising:  
a plurality of transaction servers for storing consumer sales transaction data from consumer sales transactions (Fig. 1; col 5, lines 60-65); and  
a main database server, comprising memory, coupled to the plurality of transaction servers and to the Internet, the main database server additionally comprising an apparatus, coupled to each transaction server, for downloading the consumer sales transaction data from the plurality of transaction servers (Fig. 1; col 5, lines 30-43; col 6, lines 1-15).

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Gardenswartz further discloses online sales (col 1, lines 23-27) and tracking online sales data for consumer activity for targeted advertising purposes (col 2, lines 43-55).

Gardenswartz further discloses targeted advertising to consumers utilizing known consumer information (col 2, lines 35-43).

Gardenswartz further discloses utilizing known consumer information such as consumer mailing address information to mail information to a consumer in an offline manner via regular mail (col 19, lines 17-14).

Gardenswartz further discloses providing coupons and rewards to a consumer in an offline manner such as regular mail, at a retail store, or at a checkout counter, (col 20, lines 10-25).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gardenswartz can utilize online consumer activity history in any of the manners disclosed for utilizing the offline activity history information. One would have been motivated to do this in order to form a more complete picture of user activity information for targeting purposes (col 2, lines 42-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gardenswartz's targeted offline coupon or rewards information delivered to a consumer based upon online sales information can be offline advertisements. One would have been motivated to do this in order to provide advertising in a form that is often utilized or accessed by consumers.

Claim 12, 20: Gardenswartz discloses a method for the accumulation of consumer sales transaction data, the system comprising a plurality of consumer transaction servers and a main database server having memory, the method comprising the steps of:  
standardizing the consumer sales transaction data into a predetermined format, thus generating standardized sales data; storing the standardized sales data in the main database server memory; and  
accumulating the standardized sales data for each consumer such that a group of the standardized sales data relating to a specific consumer and gathered from at least one of the plurality of consumer transaction servers is assigned to that consumer in the form of a consumer data file (Fig. 1; Fig. 2a; Fig. 2b; Fig. 4a; Fig. 9; col 5, lines 30-43; col 6, lines 1-15; col 5, lines 60-65).

Gardenswartz further discloses online sales (col 1, lines 23-27) and tracking online sales data for consumer activity for targeted advertising purposes (col 2, lines 43-55).



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Gardenswartz further discloses targeted advertising to consumers utilizing known consumer information (col 2, lines 35-43).

Gardenswartz further discloses utilizing known consumer information such as consumer mailing address information to mail information to a consumer in an offline manner via regular mail (col 19, lines 17-14).

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**2** : a form surrendered in order to obtain an article, service, or accommodation: as **a** : one of a series of attached tickets or certificates often to be detached and presented as needed **b** : a ticket or form authorizing purchases of rationed commodities **c** : a certificate or similar evidence of a purchase redeemable in premiums **d** : a part of a printed advertisement to be cut off to use as an order blank or inquiry form or to obtain a discount on merchandise”.

Definition 2d states how a coupon is related to an advertisement.

Additionally, Deaton further discloses utilizing consumer purchase history information to send targeted, offline or mailed advertisements or coupons to a consumer (col 7, lines 30-50; col 4, lines 3-10; col 61, lines 45-52; col 62, lines 53-56).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gardenswartz can utilize online consumer activity history in any of the manners disclosed for utilizing the offline activity history information. One would have been

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motivated to do this in order to form a more complete picture of user activity information for targeting purposes (col 2, lines 42-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gardenswartz's targeted offline coupon or rewards information delivered to a consumer based upon online sales information can be offline advertisements. One would have been motivated to do this in order to provide advertising in a form that is often utilized or accessed by consumers.

Claim 13, 14: Gardenswartz and Deaton disclose the method of claim 12 wherein the main database server memory comprises a hard drive, a tape drive (col 6, lines 5-15; col 21, lines 20-23).

Claim 15: Gardenswartz and Deaton disclose the method of claim 12 and further including the step of segmenting the standardized sales data for each consumer such that a group of consumers can be defined by the group's characteristics (Fig 4a; Fig. 9; Fig. 8; col 12, lines 37-48).

5. Claims 4, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz (6,055,573) in view of Deaton (5,687,322) in further view of Lech (5,258,855).

Claim 4, 16, 17: Gardenswartz and Deaton disclose the method of claim 3, and further discloses that the data fields comprise a field for the consumer's mailing address, a field for the consumer's item of purchase, and a field for the consumer's cost of purchase, and date of purchase (Fig. 2b; col 11, lines 43-50).

Gardenswartz does not explicitly disclose a field for a consumer's age.

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However, Gardenswartz discloses storing user demographic information that will assist in targeting (col 11, lines 43-50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add age as user demographic information to Gardenswartz's user information. One would have been motivated to do this in order to provide further data on a user that is useful in targeting.

Gardenswartz further discloses a wide variety of tabular and database means for storing information (col 8, lines 3-10; Fig. 2a; Fig. 2b).

Gardenswartz does not explicitly disclose the utilization of a semicolon.

However, Lech discloses that the semicolon can be utilized as a data delimiter (col 11, lines 50-57).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the Lech's semicolon is an obvious character that Gardenswartz can utilize as a delimiter for the data. One would have been motivated to do this in order to separate data of different types.

6. Claims 8-11, 18, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz (6,055,573) in view of Deaton (5,687,322) in further view of Wilson (5,864,827).

Claim 8-11, 18, 19: Gardenswartz and Deaton disclose the method of claim 7, 12.

Gardenswartz further discloses the utilization of a WAN or the Internet (col 5, lines 37-42) and a network with servers and real-time communication (Fig. 1; col 6, lines 2-5).

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Gardenswartz does not explicitly disclose the utilization of satellite, modem, telephone line with the Internet.

However, Wilson discloses the Internet and utilizing a telephone line, satellite, modem, dedicated line for networked communication (col 4, lines 8-19)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Wilson's variety of networked communications utilizing the Internet or a WAN to Gardenswartz's networked communication utilizing the Internet or a WAN. One would have been motivated to do this in order to provide Gardenswartz with appropriate options for network communications.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AD

8/10/04

  
**JAMES W. MYHRE**  
**PRIMARY EXAMINER**